

### REMARKS

This application was originally filed on 21 December 2001 with thirty-one claims, four of which were written in independent form. Claims 7, 11, and 16 have been canceled. Claims 1-6, 8-10, 12, 13, and 19-31 have been allowed. Claims 14, 15, and 17 are rejected, and Claim 18 is objected to. Claims 1, 5, 6, and 14 have been amended to broaden the claim. The amendment to Claim 14 includes the markings noted by the Examiner as being left out of the amendment filed on 26 May 2004.

Claim 14 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 5,444,566 to Gale et al. ("Gale '566"). The applicant respectfully disagrees.

"A person shall be entitled to a patent unless," creates an initial presumption of patentability in favor of the applicant. 35 U.S.C. § 102. "We think the precise language of 35 U.S.C. § 102 that, 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103, see *Graham* and *Adams*." *In re Warner*, 379 F.2d 1011, 1016 (C.C.P.A. 1967) (referencing *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and *United States v. Adams*, 383 U.S. 39 (1966)). "As adapted to *ex parte* procedure, *Graham* is interpreted as continuing to place the 'burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103'." *In re Piasecki*, 745 F.2d 1468 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d at 1016).

"The prima facie case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the

conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it.” *In re Spada*, 911 F.2d 705, 708 n.3 (Fed. Cir. 1990).

“Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.” *Graham v. Deere*, 383 U.S. 1, 17-18 (1966).

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). ‘All words in a claim must be considered in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).” MPEP § 2143.03.

“To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985).

Claim 14 recites, “a means associated with said at least one deflectable member for

selectively connecting said deflectable member to a ground potential during a period in which said bias electrodes provide a reset signal.”

The Examiner stated, “Gale et al discloses . . . a means (column 8, lines 48-59, Figure 16, “198” and “199”) associated with each said at least one deflectable member for selectively connecting said deflectable member to a ground potential (abstract, lines 11-13 and column 1, lines 53-57) . . . .”

The applicant respectfully submits that the means cited by the Examiner does not connect said deflectable member to a ground potential but rather is shown in Figure 16 and taught by column 8 lines 25 to 37, selectively connects the deflectable member to the memory address voltage “186”.

The Examiner stated Gale “does not specifically disclose wherein said means is connected to a ground potential during a period in which said bias electrodes provide a reset signal. Gale et al discloses, however, wherein said means provides a reset signal and teaches that the mirror is deflected by grounding the address electrodes and biasing the mirror (column 4, lines 42-43).”

The applicant respectfully submits that Gale ‘566, as explained above by the Examiner, teaches away from “a means selectively connecting said deflectable member to a ground potential during a period in which said bias electrodes provide a reset signal” as recited by Claim 14. As stated by the Examiner, Gale ‘566 teaches said means provides a reset signal to the deflectable member while the address electrodes are grounded.

While Gale teaches the electrostatic force to deflect the mirror is caused by the relative difference in potential between the member and the address electrodes and that the voltage

differential, not the voltage polarity, determines the electrostatic force generated, Gale '566 does not show, teach, or suggest a means for selectively connecting said deflectable member to a ground potential corresponding to the structure, material, and acts that were described in the specification, or equivalents thereof.

Furthermore Gale '566 does not show, teach, or suggest "connecting said the applicable member to a ground potential during a period in which said bias electrodes provide a reset signal." Gale '566 merely states the electrostatic force would be the same whether the address electrodes are grounded and the mirror is biased or the mirror is grounded and the address electrodes are biased.

As not all of the limitations of Claim 14 are taught or suggested by the prior art, and there is no suggestion in the prior art to so modify the prior art, the Examiner has not met the burden of presenting a prima facie case of obviousness. Therefore, the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

Claims 15 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gale '566. The applicant respectfully disagrees.

Claim 15 recites "said means for selectively connecting comprising a pass transistor." The Examiner stated, "Regarding claim 15, Gale et al discloses wherein said means for selectively connecting comprising a pass transistor (column 8, lines 35-53, Figure 16, '198' and '199')." The applicant respectfully submits, however, that the pass transistor referred to by the Examiner does not connect the deflectable member to ground.

As not all of the limitations of Claim 15 are taught or suggested by the prior art, and there is no suggestion in the prior art to so modify the prior art, the Examiner has not met the burden of

presenting a prima facie case of obviousness. Therefore, the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

Claims 17 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gale '566 in view of U.S. Patent No. 5,285,407 to Gale *et al.* ("Gale '407"). The applicant respectfully disagrees.

The Examiner stated, Gale '407 "teaches wherein said means for selectively electrically connecting comprising: a pass transistor; and a capacitor connected to a gate terminal of said pass transistor (Figure 4)."

The applicant respectfully submits that while Gale '407 this show various electrical components including transistors and capacitors, Gale '407 does not show, teacher, or suggest a pass transistor and a capacitor connected to a gate terminal of said pass transistor of used as a means of connecting a deflectable member to a ground signal. Figure 4 merely illustrates an isolation switch and pull up transistor such as are associated with each column and a single memory cell for that column. The memory cell is connected to the address electrodes, but the circuit elements of Figure 4 are not connected to the deflectable member.

As not all of the limitations of Claim 17 are taught or suggested by the prior art, and there is no suggestion in the prior art to so modify the prior art, the Examiner has not met the burden of presenting a prima facie case of obviousness. Therefore, the rejection under 35 U.S.C. § 103(a) is defective and should be withdrawn.

Claim 18 was objected to as being dependent upon a rejected base claim but the Examiner stated Claim 18 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In view of the amendments and the remarks presented herewith, it is believed that the claims currently in the application accord with the requirements of 35 U.S.C. § 112 and are allowable over the prior art of record. Therefore, it is urged that the present claims are in condition for allowance. Reconsideration of the present application is respectfully requested.

Respectfully submitted,



Charles A. Brill  
Reg. No. 37,786

Texas Instruments Incorporated  
PO Box 655474 M/S 3999  
Dallas, TX 75265  
(972) 917-4379  
FAX: (972) 917-4418